

Our Docket No: 042390P13119

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )

Eric C. Hannah )

Application No: 09/991,610 )

Filed: November 9, 2001 )

For: Carbon Nanotube Molecular Labels )

Commissioner of Patents and Trademarks  
Attn: Licensing and Review  
Washington, D.C. 20231

Examiner: Not yet assigned

Art Unit: 1614

PATENT & TRADEMARK OFFICE  
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APR 18 2002

LICENSING & REVIEW

FIRST CLASS CERTIFICATE OF MAILING

I hereby certify that I am causing the above-referenced correspondence to be deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and that this paper or fee has been addressed to the Commissioner for Patents and Trademarks, Washington, D.C. 20231.

Date of Deposit: April 18, 2002

Name of Person Mailing Correspondence: Lori E. True

Signature: Lori E. True

Date: April 18, 2002

RESPONSE TO NOTICE UNDER 42 U.S.C. §2182

Dear Sir or Madam:

In response to the Notice under 42 U.S.C. §2182, mailed on March 29, 2002, enclosed is an executed Declaration by the inventor. As indicated, the claimed invention was made during the course of and within the scope of the inventor's employment by Intel Corp. To the best of the inventor's knowledge and belief, the invention was not made under any contract, sub-contract or arrangement with the U.S. Atomic Energy Commission or the Department of Energy and was not made under any contract with the National Aeronautics and Space Administration.

If an additional fee is required, please charge Deposit Account No. 02-2666. A duplicate of this Response is enclosed for deposit account charging purposes.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 4/18, 2002

12400 Wilshire Blvd.  
Seventh Floor  
Los Angeles, CA 90025-1030  
(303) 740-1980

Richard A. Nakashima  
Reg. No. 42,023

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BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

LOS ANGELES SERIAL NUMBER	BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/991,610	DENVER/09/01 HANNAH	042390.P13119

BLAKEY, SOKOLOFF, TAYLOR & ZAFMAN  
SEVENTH FLOOR  
12400 WILSHIRE BOULEVARD  
LOS ANGELES, CA 90025

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STATUS DB-LA

APR 05 2002

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EXAMINER	
ART UNIT	PAPER NUMBER
PATENT & TRADEMARK OFFICE	

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MAR 29 2002

LICENSING & REVIEW

IF NO RESPONSE TO THIS NOTICE IS RECEIVED WITHIN FORTY-FIVE DAYS, A  
FORMAL REQUIREMENT WILL BE ISSUED

The subject matter of this application appears to:

☒ be "useful in the production or utilization of special nuclear material or atomic energy" as recited in 42 U.S.C. 2182 (Department of Energy (DOE)).

☐ "have significant utility in the conduct of aeronautical and space activities" as recited in 42 U.S.C. 2457 (National Aeronautics and Space Administration (NASA)).

Accordingly, no patent can issue on this application unless applicant(s) file a statement (under oath or in the form of a declaration as provided by 37 CFR 1.68) setting forth (1) the full facts concerning the circumstances under which the invention was made and conceived and (2) the relationship (if any) of the invention to the performance of any work under any contract or other arrangement with the Agency(ies) noted above. On the reverse side of this form is an example of an acceptable format for this statement. The language appearing in paragraphs III and/or IV of the example *must* appear if applicant is attempting to establish that no relationship (under item 2 above) exists.

If the invention disclosed in this application was developed under a contract, grant or cooperative agreement between the Agency indicated above and a person, small business or non-profit organization and rights to the invention have been determined by specific reference to 35 U.S.C. 202 in the contract, grant or cooperative agreement, then applicant need not submit the statement described above. Instead, applicant may file a verified statement (under oath or in the form of a declaration, 37 CFR 1.68) setting forth the information required by 35 U.S.C. 202(c)(6).

IF NO STATEMENT HAS BEEN RECEIVED WITHIN FORTY-FIVE DAYS OF THE MAIL DATE INDICATED ABOVE, a formal requirement for statement will then be issued. No provision is made for extension of the statutory thirty-day period for response to the formal requirement and the penalty for failure to file an acceptable and timely statement is abandonment of the application. Therefore, applicants are strongly encouraged to submit a statement at this time in order to avoid the issuance of a formal requirement.

IT IS IMPORTANT TO NOTE that the statement must accurately represent the property rights situation of the claimed invention if and when the application is found allowable. Thus, if during prosecution before the examiner, the claimed invention is so altered or the property rights situation so changed as to impact the accuracy of a statement submitted earlier, a supplemental statement must be filed. Failure to submit such additional information where appropriate may be considered a false representation of material facts and render the patent owner vulnerable to loss of patent rights and other sanctions as set forth in the statutes. The PTO will not review allowed applications for this possibility. The responsibility for complying with the statutes rests with the applicants.

Any questions regarding this requirement should be directed to Licensing and Review at (703) 306-4191.

PLEASE DIRECT ALL COMMUNICATIONS RELATING TO THIS MATTER TO THE  
ATTENTION OF LICENSING AND REVIEW

The following is an example of an acceptable property rights statement. Statements of this type are, of course, only suitable for situations in which **NO** Agency funds or other considerations were involved in the making or conception of the invention. While this example is in the form of a declaration, a sworn document is equally acceptable.

I (We) Eric C. Hannah  
citizens of United States of America  
residing at 3046 Strawberry Hill, Pebble Beach, CA 93953  
declare:  
That I (we) made and conceived the invention described and claimed in patent application:  
Serial Number 09/991,610 filed in the United States of America on November 9, 2001  
titled Carbon Nanotube Molecular Labels

(Check and complete either I or II below)

(Check III and/or IV below as appropriate)

☒ I. (For Inventors Employed by an Organization) That I (we) made and conceived this invention while employed by Intel Corporation. That the invention is related to the work I am (we are) employed to perform and was made within the scope of my (our) employment duties; That the invention was made during working hours and with the use of facilities, equipment, materials, funds, information and services of Intel Corporation. Other relevant facts are (name of employer)

That to the best of my (our) knowledge and belief (and/or) based upon information provided by \_\_\_\_\_ of \_\_\_\_\_:

—OR—

☐ II. (For Self-Employed Inventors) That I (we) made and conceived this invention on my (our) own time using only my (our) own facilities, equipment, materials, funds, information and services. Other relevant facts are \_\_\_\_\_

That to the best of my (our) knowledge and belief:

☒ III. The invention was not made or conceived in the course of, or in connection with, or under the terms of any contract, subcontract or arrangement entered into with or for the benefit of the United States Atomic Energy Commission or its successors: Energy Research and Development Administration or the Department of Energy.

—AND/OR—

☒ IV. The invention was not made (conceived or first actually reduced to practice) under nor is there any relationship of the invention to the performance of any work under any contract of the National Aeronautics and Space Administration.

The undersigned inventor(s) declare further that all statements made herein of his or her (their) own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Inventor's Signature: Eric C. Hannah

Post Office Address: 3046 Strawberry Hill, Pebble Beach, CA 93953

Date: 4/16/02

Inventor's Signature: \_\_\_\_\_

Post Office Address: \_\_\_\_\_

Date: \_\_\_\_\_